REMARKS

This Amendment and Remarks is in response to the Office Action mailed August 24, 2004. Claims 1-9 are pending and have been rejected.

The Examiner has objected to the drawings because page 13 of the application states "Figures" as the title and no figures are on the page. The applicant would like to inform the Examiner that the present application was submitted using the PTO's Patent Electronic Business Center, and was specifically authored utilizing the PTO's PASAT authoring program. Page 13, with the title "Figures," is automatically created by the PASAT program and is not within the control of the applicant. Nonetheless, if the Examiner insists upon removing the blank page from the record, as the Examiner has suggested on page 2 of the office action, the applicant would not object. Accordingly, the applicant respectfully asserts that the Examiner's objection has herein been overcome.

The Examiner has also objected to the specification stating that the application's title "Method for Providing and Exchanging Search Terms Between Internet Site Promoters" is not descriptive of the claims. The applicant respectfully disagrees. The claims set forth a method of providing, or "assigning," to an Internet site a search term, in the form of a keyword. (see e.g., Claim 1). The application further claims a method of exchanging or "adding" search terms, or keywords, among other Internet sites assigned to the same corresponding category. (see e.g., Claim 6). The Examiner's proposed title of "Method of Assigning Web Sites or Pages to a Category" is not descriptive of the claimed invention in that the assignment of an Internet site or page to a category is only a portion of the invention claimed and disclosed by the present application. Accordingly, the applicant respectfully requests the Examiner to reconsider and withdraw his objection of the title and specification.

The Examiner has also objected to the specification because the use of the trademarks Yahoo!, Google and Excite should be capitalized and accompanied by generic terminology. The applicant has herein amended paragraph 0004 of the present application, which includes the trademarked terms at issue, to capitalize the trademarks. Regarding the Examiner's statement that the terms should be accompanied by generic terminology, the applicant respectfully asserts that the trademarked terms are accompanied by such terminology. More specifically, paragraph 0004 of the present application states "...Internet users searching for products, services, or information typically use **a keyword based Internet search engine**, such as Yahoo!, Google, Excite, and the like..." (emphasis added). As such, the trademark terms Yahoo!, Google and Excite, are set forth as exemplars of the generically described "keyword based Internet search engine." Accordingly, the applicant respectfully asserts that the Examiner's objection to the specification has herein been overcome.

The Examiner has rejected claim 8 under 35 U.S.C. § 112. The Examiner has stated that the term "the mega-tag field" found in lines 4-5 of claim 8 lacks antecedent basis. The applicant has herein amended claim 8 to provide such antecedent basis. The Examiner has also rejected claim 8 stating that the applicant's definition of Internet site in paragraph 0002 refers to a logical grouping of relevant Internet pages and this definition cannot support the physical meta-tag descriptions as claimed. The applicant respectfully disagrees. "Internet site" is a term of art that is commonly used to describe a location accessible on the Internet via a Uniform Resource Location (URL) address. The applicant has not given "Internet site" any meaning that contradicts the meaning attributable to it by those skilled in the art. More specifically, the applicant has stated, in paragraph 0002, that "[a]n Internet site **typically** contains a plurality of pages that makes up that particular Internet site." (emphasis added). In other words, any "meta-

tags" that are associated with any Internet page that make up an Internet site may also be attributable to the Internet site as meta-tags for that Internet site. Further, Fig. 1 of the present application depicts an Internet site, a/k/a "website," (1) as having meta-tags. (1d) Accordingly, and in conformance with the term's common usage, "Internet site," as it is understood by those skilled in the art, does not render claim 8's limitation of "reviewing any previously assigned keywords contained within a meta-tag field of said Internet site" indefinite. As such, the applicant respectfully asserts that the Examiner's rejections have herein been overcome.

The Examiner has also rejected claim 9 under 35 U.S.C. § 112 stating that the limitation "the meta-tag field" in lines 4-5 thereof lacks sufficient antecedent basis. The applicant has herein amended claim 9 to provide such antecedent basis. Accordingly, the applicant respectfully asserts that the Examiner's rejection has herein been overcome.

The Examiner has rejected claims 1-9 under 35 U.S.C. § 103(a) under U.S. Patent no. 6,178,419 ("Legh-Smith") in view of U.S. Patent no. 5,745,899 ("Burrows"). The applicant respectfully disagrees and traverses the Examiner's rejection . The applicant respectfully asserts that the Examiner is misinterpreting the teachings of Legh-Smith. Specifically, Legh-Smith teaches a method of controlling accessible Internet sites available to Internet searchers in the form of a directory-search methodology by only listing Internet sites having specifically desired keywords that are returned in a prior keyword search, conducted by a controller, based upon a predefined keyword list that is desired by a controller. To accomplish this, Legh-Smith creates a category list (300) and a keyword list (302) containing only the keywords that the controller will search for. The keyword list (302) is created exclusively by the controller and lists the keywords that the controller desires to limit search-returned Internet sites to. (Col. 8, ln. 62 – Col. 9, ln. 1; Col. 9, ln. 28-35). In other words, Legh-Smith's keyword list (302) is used exclusively to

conduct a keyword search, where the controller searches for Internet sites matching a keyword in the list. (see Col. 5, ln. 9-11: "The keywords are for the purpose of **building** the database but do not, as such, form part of the ultimate database structure."). The keyword list (302) in Legh-Smith has nothing to do with **assigning** keywords to an Internet site, like the claimed invention. As such, Legh-Smith teaches that the respective keyword lists (302) are combined into a single keyword list (304), which is then used to conduct a conventional keyword search (306), in order to search for Internet sites and pages that match only the searched keywords that were chosen by the controller. (Col. 5, lines 15-17). The Internet sites that are returned in the keyword search are then categorized. (Col. 5, lines 23-25). In other words, the keyword lists in Legh-Smith are used **only** to conduct the keyword searching for Internet sites that have assigned their own keywords, independent of any category affiliation, and that only match the desired, listed keywords chosen by the controller. Contrary to the Examiner's interpretation, Legh-Smith does **not** teach a method of assigning, or providing, Internet pages or sites any keyword, based upon the topical category that such Internet sites or pages have been assigned to, as required by the claimed invention.

For example, independent claim 1 of the present application first provides a topical category database and assigns at least one keyword to that category to create a keyword list specific to that category. Then, the claimed invention assigns Internet sites to the categories and only then, after the Internet site or page has already been assigned to the category, it **assigns** or provides to the Internet sites at least one of the keywords contained in the keyword list for that category they were respectively assigned to, regardless of any keywords that the Internet sites previously assigned to themselves. Unlike Legh-Smith, the present invention does not use its keyword list to actively conduct any search to find Internet sites that already have keywords

contained in the list. In other words, the claimed invention of the present application does not, unlike Legh-Smith, conduct any keyword search, based upon any pre-defined keyword list, to search for Internet sites that have already assigned such desired, predefined keywords to themselves. In fact, Legh-Smith does exactly the opposite of what the present application is trying to achieve, which is consistency of keyword search results. By controlling the actual keywords that are assigned to each Internet site, based upon the category that the Internet site is assigned to, the claimed invention of the present application ensures keyword consistency amongst the sites assigned to a common category. Legh-Smith, on the other hand, relies exclusively on the Internet sites' own keyword assignments because it only searches for Internet sites that already have the desired keyword association. While it is true that Internet sites within a category in Legh-Smith may have common keywords, this is only because Legh-Smith first conducted a keyword search for Internet sites having a chosen, pre-determined specific keyword in the keyword list, but Legh-Smith does not **assign any keywords to any Internet sites assigned to a category**, unlike the claimed present invention. Again, Legh-Smith relies exclusively on searching for the desired, predetermined keywords based only upon the keywords that the Internet site operators have already independently assigned to their respective Internet sites by their own independent determination. Legh-Smith does not assign any keywords to any Internet sites, unlike independent claim 1 of the present application.

Both Borrows and U.S. patent no. 6,701,314 ("Conover"), which the Examiner indicated was pertinent to the present application, teach a method for indexing information of a database. Like Legh-Smith, Borrows and Conover also do not teach any method of assigning a keyword to an Internet site or page based upon the category that the Internet site has been assigned to. Rather, Borrows and Conover, like Legh-Smith, must first conduct their own search for Internet

sites in order to index them, unlike the claimed present invention, which relies on Internet sites being categorized and only then assigns a keyword to the Internet site from a list of keywords that are specific to the category the site was assigned to.

Even assuming, *in arguendo*, that if either Legh-Smith, Borrows or Conover teach a method of assigning a keyword to an Internet site by first assigning the Internet site to a category and then assigning a keyword, that is specific to that category, to the Internet site, which none do, the Examiner has come forth with no teaching, suggestion or incentive **from the asserted prior art** to make the combination or modification as suggested by the Examiner. *Northern Telecom, Inc. v. data Point Corp.*, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir 1990). The Examiner's assertion that one would have been motivated to combine Legh-Smith and Borrows because of the suggestions provided by Legh-Smith, without more, is insufficient. *Id.* In fact, in light of the arguments set forth above, Legh-Smith actually teaches ***against*** the presently claimed invention because Legh-Smith requires it to first search for Internet sites having specific keywords that the Internet site owners have, themselves already, independently assigned to their respective sites. The claimed invention teaches against relying solely on the Internet sites' own keyword assignments because it will lend to inconsistency amongst other comparable Internet sites within the same category. Rather, the only suggestion of the claimed invention is found in the present application and while, in hindsight, it may now appear to be simple or elementary, that is not the test for obviousness or nonpatentability. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1999).

Claims 2-9 depend on Independent claim 1. Accordingly, the applicant respectfully asserts that the claims, as herein presented, are patentable over the prior art of record, either

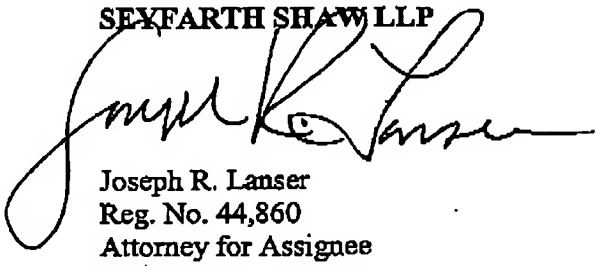
alone or in combination, and the applicant requests the Examiner to reconsider and withdraw his rejections.

CONCLUSION

In view of the foregoing, and in summary, the applicant respectfully asserts that the claims are considered patentable and are in a condition for allowance. Therefore, allowance of the application is respectfully requested.

Respectfully Submitted,

SEYFARTH SHAW LLP



Joseph R. Lanser
Reg. No. 44,860
Attorney for Assignee

SEYFARTH SHAW LLP
55 East Monroe Street, 42nd Floor
Chicago, Illinois 60603-5803
phone: (312)346-8000
facsimile: (312)269-8869
customer number: 27717